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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,771	11/21/2000	Koji Hayashi	10449-028001	9013

7590 12/13/2001

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2651

DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,771

Applicant(s)

HAYASHI, KOJI

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 34. 6) ☐ Other: _____

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The IDS of 4/13/01 and 9/27/01 have been received and acknowledged. Because the second IDS corrects for errors in the first IDS, only the second IDS has been marked as being reviewed by the examiner. There are NO TRANSLATIONS OF THE JP documents. Abstracts of the JP documents have been reviewed, not the entire JP document.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed ability of control the recording operation by way of a controller for the laser source, does not reasonably provide enablement for all controllers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants' attention is drawn to *In re Hyatt, 218 USPQ 195*. This is a single means rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 3,4, 5, 6, 8, and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by JP document 2000-040302.

As ascertained from the abstract, the system inherently possesses a control, if nothing else, the microprocessor. This type of device inherently possesses the memories, storage units necessary to perform the restart – resumed recording ability – mentioned in the abstract from the last recording position.

With respect to the limitations of claims 5 and 6, these are formats that the examiner considers inherently present in the system, i.e., sync pattern, sector address. The limitations of claim 5 are interpreted to be the buffer underrun detection. The method claims 8 & 9 are met when the system is operational.

6. Claims 3, 4,5,6,8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by JP document 10-063433.

As far as the examiner can ascertain from the abstract, the system possesses a control device, element 8 in figure 3, and as recited upon resume the information commences from the interrupt position. The examiner concludes therefore that the elements to store the address location, and sync. operations are inherently present. Again, with respect to the limitations of claims 4 & 5, the formats are considered present. The underrun capability is interpreted as the limitation of claim 6. The method limitations of claims 8 and 9 are met when the above system operates.

7. Claims 3, 4,5,6,8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakx.

Bakx teaches both a recording and reproducing system wherein the laser power is controlled during interrupt periods predicated upon memory/buffer conditions. The system restarts the function (recording or reproducing) upon the condition no longer being valid. Again, the examiner considers the address ability/unit and the sync. Operation to be inherently present in the Bakx device, as is the format limitations of claims 4 & 5.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 3 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 and 12 and 13 respectively of copending Application No. 09/717772 in view of Bakx.

The present claims differ from the corresponding claims in the copending application by lacking the buffer memory and optical head limitations. These limitations are taught by the Bakx reference which teaches using such an interrupt controller in the overall optical environment.

It would have been obvious to one of ordinary skill in the art to modify the system of the present claims with the teaching(s) from Bakx, motivation being to use the interrupt controller in the intended environment as taught/acknowledged by the Bakx reference.

This is a provisional obviousness-type double patenting rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watanabe et al is cited as illustrative of a shockproof device, interrupt condition/state wherein the address and sync. Operations are more detailed.

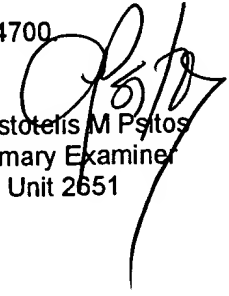
Yasukohchi et al is cited as a recording interrupt system wherein buffer condition is detected and substitute sectors are used for recording purposes. Shintani is cited as buffer memory and control abilities to ensure proper sync. Operations there between. Tomimitsu is a jump back operational system wherein upon the appropriate state, the system commences at the previous position. Takagi et al teaches the ability of using subcode information to synchronize the data in the system after interruption occurs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Aristotelis M Psitos
Primary Examiner
Art Unit 2651

AMP
December 11, 2001